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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,709	12/02/2003	Teruaki Itoh	160-400 (AMK)	2216
23117 7590 04/09/2008 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
WRIGHT, PATRICIA KATHRYN				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
04/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/724,709

Applicant(s)

ITO, TERUAKI

Examiner

P. Kathryn Wright

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 7/30/2007

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 11, 2008 has been entered.

Status of the Claims

2. This action is in response to papers filed February 11, 2008 in which claim 1 was amended. The amendments have been thoroughly reviewed and entered. Any objection/ rejection not repeated herein has been withdrawn.

Claims 1 and 3 are under prosecution.

Information Disclosure Statement

3. The information disclosure statement (IDS) filed May 04, 2005 (and the duplicate filed July 30, 2007) are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: pins in the lifting plate and the slits in the auxiliary plate as discussed in the specification at page 7, line 19- page 8, line 6. These essential elements of the invention, as defined by Applicant in the specification, are omitted from the claims. Thus, it is unclear from claim 1 how the auxiliary plate is "mounted to" one side of the adjacent lifting plate and yet capable of "sliding up and down" only in accordance with the movement of the lifting plate. The claims are incomplete since it is not clear from the claims how the auxiliary plate is mounted to the lifting plate and slidable up and down in accordance with the movement of the lifting plate.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizuka (JP 2002-306952).

Ishizuka teaches an automatic tube-type specimen container supply apparatus comprising a container storing box 1 having an insertion port (top opening of the container; Fig. 1), and a bottom with a tapered (slanted) surface creating a container collecting position in a lowest part thereof to collect a plurality of tube-type specimen containers D.

The Ishizuka apparatus also includes a container individually-sending mechanism 22 configured to lift up specimen containers collected in the container collecting position along one side wall 34 located approximate to the container collecting position.

The apparatus of Ishizuka includes an outlet 34a formed in the one side wall to discharge the specimen containers outside the storing box lifted up by the container individually-sending mechanism, and a container carry-out mechanism including a chute 5, which acts as a conveyor since it automatically carries out the discharged specimen containers.

The container individually-sending mechanism of Ishizuka includes a lifting plate 22 driven up and down by a drive source (piston, P2); the lifting plate has a top end with a tapered surface 22a descending toward the outside of the container storing box (see

Figs. 2 and 5). Ishizuka also teaches an auxiliary plate 21 having a tapered surface 21a. The auxiliary plate 21 is mounted on one side of the lifting plate 22 via reinforcement section 23c (see paragraph [0017] of the English translation of Ishizuka and Figs. 4a-d).

The drive source P2 of Ishizuka drives only the lifting plate 22 (see Fig.s 2a) such that the auxiliary plate is slidable up and down only "in accordance with" the movement of the lifting plate. Note that the claim language does not preclude a separate drive source (i.e., piston, P1) from driving the auxiliary plate in accordance with (i.e., conformance) the lifting plate. Clearly, the auxiliary plate 21 of Ishizuka must move up and down in via piston P1 "in accordance with" the piston P2 of driving plate 22 so as to transport the elements D into the container carry-out mechanism.

Also note that the language in claim 1 directed to manner in which the auxiliary plate and lifting plate operate does not impart patentability to the claims because they are directed to how the apparatus functions; whereas, patentability in an apparatus claim is determined by the structure of the device. The apparatus claims must be structurally distinguishable from the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. Nevertheless, the auxiliary plate 21 of Ishizuka has a top end with a tapered surface 21a that descends toward the outside of the container storing box, the top end of the auxiliary plate being flush with that of the lifting plate when the lifting plate

descends (Fig. 4c) and being located in a lower level than that of the lifting plate when the lifting plate ascends (Fig. 4b).

Ishizuka differs from the instant invention in that Ishizuka does not teach the tapered surface of the lifting plate having space to place a single specimen container in a side-by-side manner. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Ishizuka so that the tapered surface of the lifting plate only has enough space to place one specimen container in a side-by-side manner to prevent the outlet from becoming jammed with too many containers. Furthermore, it has been held that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device, the dimensions are considered a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed device is significant, see MPEP 2144.04.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizuka in view of Portyansky (US Patent no. 4,567,997).

The teachings of Ishizuka have been summarized previously, *supra*. Ishizuka does not specifically disclosed the container storing box having a two-layer structure including a first partition plate and a second partition plate that are vertically opposed to each other. The first partition plate having a tapered surface that descends from one side to the other side, and the second partition plate having a tapered surface that descends in a direction opposite to the tapered surface of the first partition plate, and a

path is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Portyansky teach a stick delivery mechanism (Fig. 1) comprising, *inter alia*, a container storing box 12 having a two-layer structure including a first partition plate 16 and a second partition plate 22, 24 that are angled downwardly with respect to a horizontal plane. The first partition plate having a tapered (slanted) surface that descends from one side to another side, and the second partition plate having a tapered (slanted) surface that descends in a direction opposite to the tapered surface of the first partition plate, and a path 26 is formed between the first and second partition plates to allow one specimen container to pass therethrough.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Ishizuka to include the partition configuration, as taught by Portyansky, in order to help prevent more than one container from disposal through the outlet so as to prevent the outlet from becoming blocked by too many containers simultaneously flowing therethrough.

Response to Arguments

10. Applicant's arguments filed February 11, 2008 have been fully considered but they are not persuasive.

With respect to the previous rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Ishizuka (JP 2002-306952), Applicant argues that Ishizuka lacks the

drive source driving only the lifting plate and the auxiliary plate being slidable in accordance with the movement of the lifting plate as defined in claim 1.

The Examiner respectfully disagrees with Applicant's assertion. As pointed out above, the claim language merely requires the lifting plate 22 be driven up and down by a drive source (piston, P2). The claim language does not preclude a separate drive source (piston, P1) from driving the auxiliary plate in accordance with (i.e., agreement with) the lifting plate. Clearly, the auxiliary plate 21 of Ishizuka must move up and down in via piston P1 in accordance with the piston P2 of driving plate 22 so as to transport the elements D into the container carry-out mechanism.

Therefore, for the reasons delineated above, claims 1 and 3 remain rejected under 35 U.S.C. 103(a).

Conclusion

11. No claims allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is 571-272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pkw

/Jill Warden/

Supervisory Patent Examiner, Art Unit 1797